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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,968	11/18/2003	James D. Ralph	SPINE 3.0-438 CONT CONT	5372
51640	7590	08/21/2007		
SPINE MP LERNER, DAVID, et al. 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER PHILOGENE, PEDRO	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 08/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,968

Applicant(s)

RALPH ET AL.

Examiner

Pedro Philogene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,16-18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18 is/are allowed.
- 6) ☒ Claim(s) 1,3,8,12,15-17 and 21 is/are rejected.
- 7) ☒ Claim(s) 4-7,9-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskovich (5,431,658) in view of Aebi et al. (6,261,296).

With respect to claim 1, Moskovich discloses an instrument for inserting an implant between vertebral bodies, comprising a holder (1,2) adapted to hold the implant during insertion of the implant between the vertebral bodies, a retractor (21,22) adapted to retract the holder away from the implant after insertion, and a guard (26) adapted to prevent the implant from being removed from between the vertebral bodies during retraction, as best seen in FIG.6; wherein the retractor comprises a threadable coupling (23) adapted to couple the holder to the guard and by which relative movement between the holder and the guard is effectable during the retraction, as best seen in FIG.6, wherein the retractor comprises a threaded coupling that includes a (threaded) bore and a screw (25) that is threadable within the bore, such that rotation of the screw within the bore effects relative movement between the holder and the retractor; as best seen in FIG.6; as set forth in column 3, lines 25-60.

With respect to claims 3, 8 Moskovich discloses all the limitations, as set forth in column 3, lines 25-60, and as best seen in FIGS.1-8.

It is noted that Moskovich did not teach of extensions hingedly connected to the distal ends of the plurality of arms; as claimed by applicant. However, in a similar art, Aebi et al, column 6, lines 45-67, evidences the use of holder having distal ends including extensions hingedly connected to the distal ends of the plurality of arms to facilitate manipulation of the extension with respect to the vertebral endplates to ease removal of the extensions and distractor.

Therefore, given the teaching of Aebi et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Moskovich, as taught by Aebi et al, to facilitate manipulation of the extension with respect to the vertebral endplates to ease removal of the extensions and distractor.

Claims 12,16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskovich (5,431,658) in view of Witter (2,167,287).

With respect to claim 12, Moskovich discloses an instrument for inserting an implant between vertebral bodies, comprising a holder (1,2) adapted to hold the implant during insertion of the implant between the vertebral bodies, a retractor (21,22) adapted to retract the holder away from the implant after insertion, and a guard (26) adapted to prevent the implant from being removed from between the vertebral bodies during retraction, as best seen in FIG.6; wherein the retractor comprises a threadable coupling (23) adapted to couple the holder to the guard and by which relative movement between the holder and the guard is effectable during the retraction, as best seen in FIG.6, wherein the retractor comprises a threaded coupling that includes a (threaded) bore and a screw (25) that is threadable within the bore, such that rotation of the screw within

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the bore effects relative movement between the holder and the retractor; as best seen in FIG.6; as set forth in column 3, lines 25-60.

With respect to claims 16-17 Moskovich discloses all the limitations, as set forth in column 3, lines 25-60, and as best seen in FIGS.1-8.

It is noted that Moskovich did not teach of a shaft having a shape tapered inwardly from the distal to the proximal shape; as claimed by applicant. However, in a similar shaft, Witter evidences the use of a shaft (piston) having a shape tapered inwardly from the distal end to the proximal end to increase the transverse dimension of the holder.

Therefore, given the teaching of Witter, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Moskovich, as taught by Witter, to increase the transverse dimension of the holder.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moskovich (5,431,658) in view of Witter (2,167,287) in view of Aebi et al. (6,261,296).

It is noted that the above combination of references teaches all the limitations, except for extensions hingedly connected to the distal ends of the plurality of arms; as claimed by applicant. However, in a similar art, Aebi et al, column 6, lines 45-67, evidences the use of holder having distal ends including extensions hingedly connected to the distal ends of the plurality of arms to facilitate manipulation of the extension with respect to the vertebral endplates to ease removal of the extensions and distractor.

Therefore, given the teaching of Aebi et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of

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Moskovich/Witter, as taught by Aebi et al, to facilitate manipulation of the extension with respect to the vertebral endplates to ease removal of the extensions and distractor.

Allowable Subject Matter

Claims 4-7, 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 18 is allowed.

Response to Amendment

Applicant's arguments, see Remarks, filed 5/21/07, with respect to the rejection(s) of claim(s) 1,3-12,17-18 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Aebi et al./Witter et al.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
August 16, 2007


PEDRO PHILOGENE
PRIMARY EXAMINER